

Appl. No.

:

59/836,436

Filed

:

April 17, 2001

Restriction Requirement, Applicants reserve the right to prosecute Claims 53-59 in divisional applications under the provisions of 35 U.S.C. § 121.

Applicants respectfully request reconsideration and withdrawal of the Restriction Requirement. As noted above, the preamble of Claim 53 has been amended. Although Claim 53 is an independent claim, which incorporates most of the features of Claim 1, it also adds additional features. Further, Claim 53 includes features that largely parallel dependent Claim 18, while adding, for example, a selecting step. Claim 53 was written as an independent claim as a matter of claim strategy, and not purposes of setting forth a separate invention for restriction purposes. As such, Claim 53 and its dependent claim should be examined together with Claim 18 and the other claims of Group I, just as they presumably would have been if written in dependent form.

Furthermore, Applicants respectfully request reconsideration and withdrawal of the Restriction Requirement as it pertains to Claim 55 and its dependent claims. As noted above, the preamble of Claim 55 has been amended. Also, Claim 55 is an independent claim that incorporates most of the features of Claim 1, but which also adds additional features. Furthermore, Claim 55 includes features that largely parallel dependent Claim 22, while adding, for example, a selecting step. As with Claim 53, Claim 55 was written as an independent claim as a matter of claim strategy, and not for purposes of setting forth a separate invention for purposes of restriction. As such, Claim 55 and its dependent claims should be examined together with Claim 22 and the other claims of Group I, just as they presumably would have been if written in dependent form.

### CONCLUSION

In light of the above amendments and remarks, reconsideration and withdrawal of the Restriction Requirement is specifically requested. If the Examiner finds any remaining issues that could be clarified with a telephone conference, the Examiner is respectfully requested to initiate the same with the undersigned.

Appl. No.

:

59/836,436

Filed

:

April 17, 2001

Please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 11-1410.

Respectfully submitted,

KNOBBE, MARTENS, OLSON & BEAR, LLP

Dated: 11/1/02

By: M. T. Morley

Marc T. Morley

Registration No. 52,051

Attorney of Record

2040 Main Street

Fourteenth Floor

Irvine, CA 92614

(619) 235-8550

S:\DOCS\MTM\MTM-3453.DOC\102902

**VERSION WITH MARKINGS TO SHOW CHANGES MADE**

**IN THE CLAIMS:**

**Please amend Claims 53 and 55 as follows:**

53. (Amended) A method for cloning a nucleic acid insert into a vector[selecting for successful transformation of a vector by a nucleic acid insert] comprising:

providing a nucleic acid insert flanked by first and second adapter sequences that is adapted for recombining with homologous sequences in a vector, and wherein the vector has a dysfunctional selection marker lacking a critical element and said nucleic acid insert contains said critical element;

contacting the nucleic acid insert with the vector to effect recombination at homologous sites such that the said critical element is supplied to the vector by the nucleic acid insert and said dysfunctional selection marker is restored to a functional one; and,

selecting the successfully restored selection marker based upon growth of a host containing the successfully recombined vector that allows the host to grow or be identified in a selective environment.

55. (Amended) A method for cloning a nucleic acid insert into a vector[selecting for successful transformation of a vector by a nucleic acid insert] comprising:

providing a nucleic acid insert flanked by first and second adapter sequences that is adapted for recombining with homologous sequences in a vector, and wherein the vector includes a negative selection element detrimental to cell growth;

contacting the nucleic acid insert with the vector to effect recombination at homologous sites such that said negative selection element is disabled; and,

selecting for successful transformation based on the absence of a functional negative selection element.